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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/580,290

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EXAMINER

TAYLOR, NICHOLAS R

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,290	Applicant(s) SON ET AL.	
	Examiner Nicholas Taylor	Art Unit 2441	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-105 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-105 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/16/07; 7/6/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 45-105 have been examined and are rejected.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 45-105 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-58 of copending Application No. 10/580,483. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Application No. 10/580,483	The Instant application
1. An Event Reporting system for requesting and processing a report on an Event that occurs upon a use of a digital item, comprising:	45. An Event Reporting system for processing an Event Report data in order to report an Event occurred in accordance with use of a digital item, the Event Report system comprising:
an Event Report Request data processing means for creating an Event Report Request data which requests a report on an Event Report data; and	Event Report Request processing means for generating and delivering an Event Report Request data requesting to report an Event in response to user's request; and

an Event Report data processing means for creating and transmitting an Event request in response to the Event Report Request data transmitted from the Event Report Request data processing means to perform an Event Reporting.	Event Report processing means for generating and delivering an Event Report data reporting the Event specified in the Event Report Request data.
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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 45-90 and 105 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 45-70, the “system” and “apparatus” claims are not a process, machine, manufacture, or composition of matter. The claimed element’s “system,” “apparatus,” and “data” are non-structural limitations, and in light of the specification these are disclosed as being software (e.g., see Spec pg. 8, lines 10-14 defined as an application program). Therefore, the claimed subject matter as a whole fails to fall within a patent-eligible category of subject matter.

Claims 71-90 are rejected for similar reasons, noting that independent claim 71 refers to a “method system.”

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As per claim 105, the “recording medium” would reasonably be interpreted by one of ordinary skill in the art as failing to fall within a statutory category of invention, because applicant’s disclosure does not define “recording medium” to be limited to statutory embodiments that include transitory propagated signals (e.g., carrier waves; see specification pg. 8, where only a non-exhaustive list of examples are given). Thus, applying the broadest reasonable interpretation in light of the specification and taking into account the meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, the claims cover both transitory and non-transitory media. A transitory medium does not fall into any of the four categories of invention (process, machine, manufacture, or composition of matter).

Claim Objections

7. Claims 58, 84, 85, 94, and 101 are objected to because of the following informalities:

Claims 58, 84, and 85, e.g., repeatedly redefine the acronym “ID.”

Claim 94 uses all caps.

Claim 101 has no ending punctuation.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 50, 53-56, 59, 60, 62-68, 71-73, 76, 78, 79-82, 86, 88-91, 93, 95-98, 100, and 102-105 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically:

Claims 50, 53, 76, 78, and 79, contain “one of after on” and “before after a third time.”

Claims 54 and 80 contains “is transmitted in mandatory” and “transmitted in optional.”

Claims 55, 56, 66, 67, 68, 81, 82, 88-90, 93, 95-97, 100, and 102-104 are written in a mixture of eXtensible Markup Language and tables rather than in the English language. As such, the patentable subject matter and relevance is unclear. See MPEP § 2173.02. Additionally, the use of tables is permitted only in exceptional circumstances where there is no practical way to define the invention in words. See MPEP § 2173.05(s).

Claim 59 contains “at the first.”

Claims 60 and 86 contain "for example" (e.g.,) that fails to clearly define the boundaries of the claimed limitation.

Claims 62, 65, 94, and 101 contain “ER” without proper antecedent basis.

Claims 63 and 64 contain “ERR” without proper antecedent basis.

Claims 71-73, 91, 98, and 105, refer to "from the outside" and "from an outside," which is ambiguous as to scope as no reference is supplied defining what the "outside" positioning is relative to.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 45-54, 69-80, 91, 92, 98, and 99 are rejected under 35 U.S.C. 102(a) as being anticipated by "Requirements for Event Reporting" by the ISO WG11 Requirements Group (hereafter referred to as "WG11", and further incorporating WG11's "Current Vision on Event Reporting in MPEG 21," hereafter, "Vision," for clarity and background).

As per claims 45 and 71, WG11 teaches a method for processing an Event Report Request data in order to report an Event occurred in accordance with use of a digital item, the method system comprising the steps of:

a) generating and delivering an Event Report Request data requesting to report an Event, (WG11, section 2 where an event report request is created and transmitted; see also sections 3.1 and 4.1 event report requests)

receiving an Event Report request data from an outside and analyzing the Event Report Request data received from the outside, and monitoring whether or not the Event specified in the Event Report Request data received from the outside; and (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3 where events are received, analyzed, and monitored)

b) Event Report processing means for generating and delivering an Event Report data reporting the Event specified in the Event Report Request data, analyzing an Event Report data received from an outside, and delivering an analysis result (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3; see also Visions appendix B use case scenario).

As per claims 46 and 72, WG11 teaches the system further wherein the step a) includes the steps of: generating the Event Report Request data; transmitting the Event Report Request data; receiving an Event Report Request data from the outside; analyzing the Event Report Request data received from the outside; and monitoring whether or not the Event specified in the Event Report Request data received from the outside occurs (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3; see also Visions appendix B use case scenario).

As per claims 47 and 73, WG11 teaches the system further wherein the step b) includes the steps of: generating the Event Report data; transmitting the Event Report data; receiving an Event Report data received from the outside; analyzing the Event Report

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data received from the outside (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3; see also Visions appendix B use case scenario).

As per claims 48 and 74, WG11 teaches the system further wherein the Event Report Request data includes Delivery Time information describing time for transmitting the Event Report data, wherein the Delivery Time information includes: a specific time; an elapsed time; and a periodic time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 49 and 75, WG11 teaches the system further wherein the specific time includes information requesting to transmit the Event Report data at least one of on a first time, after the first time, before a second time and between the first time and the second time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 50 and 76, WG11 teaches the system further wherein the elapsed time includes information requesting to transmit the Event Report data at least one of after on, before after a third time, before a fourth time and between the third time and the fourth time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 51 and 77, WG11 teaches the system further comprising Time information describing time on which the Event occurs, wherein the Time information

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includes: a specific time; an elapsed time; and a periodic time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 52 and 78, WG11 teaches the system further wherein the specific time includes information on which the Event occurs at least one of on a first time, after the first time, before a second time and between the first time and the second time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 53 and 79, WG11 teaches the system further wherein the elapsed time includes information on which the Event occurs at least one of after on, before after a third time, before a fourth time and between the third time and the fourth time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

As per claims 54 and 80, WG11 teaches the system further wherein the Event Report Request data further includes To Whom information, wherein the To Whom information includes: a mandatory recipient to whom the Event Report data is transmitted in mandatory; and an optional recipient to whom the Event Report data is transmitted in optional (WG11, see, e.g., requirements 2.4 in light of additional requirement 2.6).

As per claims 69 and 70, WG11 teaches an apparatus for requesting to report an Event and processing an Event Report Request data in order to report an Event occurred in accordance with use of a digital item, the apparatus comprising:

Event Report Request generation means for generating the Event Report Request data; Event Report Request transmission means for transmitting the Event Report Request data; (WG11, section 2 where an event report request is created and transmitted; see also sections 3.1 and 4.1 event report requests)

Event Report Request receiving means for receiving an Event Report Request data; Event Report Request analysis means for the Event Report Request data received in the Event Report Request receiving means; and Event occurrence monitoring means for monitoring whether or not an Event occurs (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3 where events are received, analyzed, and monitored).

As per claims 91 and 98, WG11 teaches a method for requesting to report an Event and processing an Event Report Request data in order to report an Event occurred in accordance with use of a digital item, 5 the method comprising steps of:

a) generating and delivering the Event Report Request data; and (WG11, section 2 where an event report request is created and transmitted; see also sections 3.1 and 4.1 event report requests)

b) receiving an Event Report Request data from an outside, analyzing the Event Report Request data received from the outside and monitoring whether or not an Event specified in the Event Report Request data received from the outside occurs (WG11, sections 2, 3.1, 4.1 and “Vision” section 3.1-3.3 where events are received, analyzed, and monitored; see also Visions appendix B use case scenario).

As per claims 92 and 99, WG11 teaches the system further wherein the Event Report Request data includes Delivery Time information describing time for transmitting the Event Report data, wherein the Delivery Time information includes: a specific time; an elapsed time; and a periodic time (WG11, section 7 requirements 2.8, 2.9, 2.10, and 3.15).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. This includes:

U.S. PGPub 2003/0018798, which describes a method of MPEG event modeling using a description model and U.S. PGPub 2002/0095429, which describes a method of managing a digital item including event management.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Business Center (EBC) at 866-217-9197 (toll-free).

/NT/

Nicholas Taylor

Examiner

Art Unit 2441

/Larry Donaghue/

Primary Examiner, Art Unit 2454